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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,298	10/16/2003	Donagh O'Shaughnessy	P1369 US	9179

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MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

OSELE, MARK A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,298

Applicant(s)

O'SHAUGHNESSY ET AL.

Examiner

Mark A. Osele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No: _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 7, 9, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Miki et al. Miki et al. shows the method of heat fusion welding two overlapping portions of polymeric material comprising a catheter shaft and a balloon neck to create a joint and thereafter applying a tensile force to the joint region while applying heat to elongate the joint region, thus thinning the joint region (column 17, lines 1-34; Figs. 11-12).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miki et al. As shown in paragraph 2 above, Miki et al. shows the instantly claimed invention but fails to explicitly state that the heating is accomplished by hot air. Hot air is known to be a conventional method of heating a polymeric material and is generally preferable to heating with a flame or a hot iron because hot air is easier to control and prevent dripping of the polymeric material. Therefore, if the invention of Miki et al. does not use hot air, It would have been obvious to one of ordinary skill in the art at the time the invention was made to use hot air as the heating method because this is known to be an effective heating method for polymeric materials. Furthermore, Miki et al. fails to directly disclose the stretching to occur between clamps. Although Miki et al. discloses that the joint region is clamped and elongated, it is unclear where the clamp or clamps are located. It would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp the end points of the elongated region and stretch the area therebetween because this provides control over which area is to be elongated and which area is to remain in its original state (See also NL 6814117).

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5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miki et al. As shown in paragraph 2 above, Miki et al. shows the claimed limitations except for the amount of tensile force applied. Absent the showing of unexpected results, the amount of force required to achieve the desired elongation would be determined by one of ordinary skill in the art as a matter of routine optimization because it is a result effective variable which determines the amount of elongation and thinning accomplished.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miki et al. in view of Vannan et al. As shown in paragraph 2 above, Miki et al. shows the claimed limitations except for the joint being elongated while cold. Vannan et al. shows the method of welding two overlapping portions of polymeric material to create a joint and applying a tensile force to the joint region to elongate the joint region, thus thinning the joint region (column 6, lines 29-42, Figs. 5, 6). The tensile force appears to be applied to a cold joint. It would have been obvious to one of ordinary skill in the art at the time the invention was made to elongate the joint of Miki et al. while cold because Vannan et al. shows an analogous bonding and stretching method which is simpler because it does not require additional heat during the elongation process.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miki et al. in view of the admitted prior art. As shown in paragraph 2 above, Miki et al. shows the claimed limitations except for the process being completed on a mandrel. The instant specification discloses that mandrels are used during elongation of a balloon and

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catheter joint to ensure an appropriate inside diameter (paragraph 0008). It would have been obvious to one of ordinary skill in the art at the time the invention was made to complete the method of Miki et al. on a mandrel because the admitted prior art teaches this to give good quality control for the inside diameter.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 3-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK A. OSELE
PRIMARY EXAMINER

October 3, 2005